REMARKS

The undersigned notes that in the Office Action mailed December 30, 2003, it is indicated that the Office Action is responsive to the papers filed January 11, 2002, in the above-identified application; and that claims 1, 26 and 29 are being considered in this Office Action mailed December 30, 2003.

However, attention is respectfully directed to the Supplemental Preliminary Amendment filed January 25, 2002, in connection with the above-identified application. A copy of this Supplemental Preliminary Amendment is enclosed, having a signature thereon of an attorney then in the office of the undersigned. Also enclosed is a postcard receipt from the U.S. Patent and Trademark Office, acknowledging receipt of this Supplemental Preliminary Amendment filed January 25, 2002. Even noting 37 CFR 1.115, this Supplemental Preliminary Amendment was timely filed. Note 37 C.F.R. §1.115(b)(2). Clearly, the claims as in the Supplemental Preliminary Amendment are officially of record in the above-identified application, and must be considered by the Examiner in, e.g., a first Office Action on the merits in the above-identified application.

The consideration of claims 1, 26 and 29 in the Office Action mailed December 30, 2003, is again noted. As claims 1, 26 and 29 have previously been cancelled in the Supplemental Preliminary Amendment filed January 25, 2002, it is respectfully submitted that rejections in the Office Action mailed December 30, 2003, as well as the Office Action itself, are null and void; and it is respectfully submitted that the enclosed Supplemental Preliminary Amendment filed January 25, 2002, together with the present remarks, constitute a full and complete response to the Office Action mailed December 30, 2003.

By the present amendments, Applicants are amending method claims 46 and 49, added by the Supplemental Preliminary Amendment filed January 25, 2002, to set forth these claims in independent form. That is, claims 46 and 49 have been amended to recite that the method comprises polishing the substrate (or the recited semiconductor chip having a silicon film formed thereon) using, or with, the abrasive comprising cerium oxide particles and having crystal grain boundary and maximum diameter as expressly set forth in claim 30. Moreover, claims 35 and 45 have been amended to correct typographical errors therein; see the paragraph bridging pages 3 and 4, and the first full paragraph on page 16, of Applicants' specification.

Rejection of claims 26 and 29 under the second paragraph of 35 U.S.C. §112, set forth in Item 2 on page 2 of the Office Action mailed December 30, 2003, is noted. As related to the claims presently in the application (noting especially method claims 46 and 49), it is respectfully submitted that this rejection is moot in that claims 46 and 49 are independent method claims, reciting processing using a specific abrasive. It is respectfully submitted that claims 46 and 49 are proper method claims; and, in particular, are not "method and process claims depending from an apparatus claim", as alleged by the Examiner with respect to claims 26 and 29.

The obviousness-type double patenting rejection of claim 1, set forth in Item 4 on page 3 of the Office Action mailed December 30, 2003, is noted. For facilitating proceedings in connection with the above-identified application, and notwithstanding differences between present claim 30 and claim 1, Applicants are submitting herewith a Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c), with respect to U.S. Patent No. 6,343,976. In view of this Terminal Disclaimer, any possible obviousness-type double patenting rejection is moot.

It is respectfully submitted that this Terminal Disclaimer is being presently filed in order to facilitate proceedings in connection with the above-identified application, so as to achieve earliest possible issuance of a U.S. Patent based upon the above-identified application. It is respectfully submitted that the present filing of this Terminal Disclaimer does not constitute an admission as to the propriety of, or agreement with, the obviousness-type double patenting rejection; and does not constitute an admission as to the propriety of, or agreement with, arguments made by the Examiner in connection with this obviousness-type double patenting rejection.

In view of the foregoing, it is respectfully submitted that a full and complete response has been made to the Office Action mailed December 30, 2003, in that this Office Action mailed December 30, 2003, is null and void as issued because at such time claims 1, 26 and 29 were not in the above-identified application. It is respectfully submitted that in view of the Supplemental Preliminary Amendment filed January 25, 2002, there effectively has been no examination on the merits of the claims in the above-identified application, such that any further Office Action rejecting claims must not be made a Final rejection.

In any event, and noting present arguments addressing rejections set forth in the Office Action mailed December 30, 2003, it is respectfully submitted that all claims presently in the above-identified application should be allowed; and, accordingly, consideration of the claims in the above-identified application, and allowance of all claims in the above-identified application, are respectfully requested.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. Please charge any shortage of fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account of Antonelli,

Terry, Stout & Kraus, No. 01-2135 (Application No. 566.38683CX1), and please credit any excess fees to said deposit account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

By _____
William I. Solomon (Reg. No. 28,565)
Attorney for Applicant(s)

WIS/btd

1300 North Seventeenth Street, Suite 1800
Arlington, Virginia 22209
Tel.: (703) 312-6600
Fax: (703) 312-6666